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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,881	06/06/2006	Satoshi Niwano	2006_0823A	3935

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EXAMINER	
RAVETTI, DANTE	

ART UNIT	PAPER NUMBER
3685	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,881	NIWANO ET AL.	
	Examiner	Art Unit	
	DANTE RAVETTI	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *1-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This communication is in response to the original Application No. 10/581,881 filed on June 6, 2006.

2. Claims 24-35 are currently pending and have been fully examined.

3. Claims 1-23 have been cancelled by the Applicant.

4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

Priority

5. Priority for this application is set to 01/08/2004, the filing date of the Foreign Application #: 2004-003431.

6. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112.[1]

[1] Transco Products, Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Examiner's Comments/Remarks

7. In light of Applicant's choice to pursue system claims, Applicants are also reminded that functional recitations using the word "for," "adapted to", "configured to," or other functional terms (e.g. see claim 24 which recites "first license generation unit **operable to** generate, in a first format...a modification detection information generation unit **operable to** generate...information receiving unit **operable to** receive ...") have been considered but are given little patentable weight[2] because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However a recitation of the intended use in a system claim must result in a structural difference between the claimed system and the prior art in order to patentably distinguish the claimed system from the prior art. Claims 27-29, 32 and 34 contains similar language.

As to claim 24, Applicant recites, "... a use unit operable to use the content according to the first license in the case **where** the judgment unit judges that no modification is made...**depending** on a transmission path...." The MPEP interprets claim limitations that contain "if, may, might, can, when and could" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.[3] Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a

[2] *See e.g. In re Gulack, 703 F.2d 1381, 217 USPQ 401,404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).*
[3] In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006);

particular structure does not limit the scope of a claim or claim limitation.[4] The appropriate correction is required.

As to claim 25, Applicant recites, "...wherein, **in the case** where a frequency band of the transmission path is narrower than a predetermined frequency band or a communication speed of the transmission path is slower than a predetermined communication speed,...." The MPEP interprets claim limitations that contain "if, may, might, can, when and could" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.[5] Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.[6] The appropriate correction is required.

As to claim 29, Applicant recites, "...the second format being different from a format used **when** the first license is generated..." The MPEP interprets claim limitations that contain "if, may, might, can, when and could" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.[7] Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.[8] The appropriate correction is required.

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[4] MPEP §2106 II C;
[5] In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006);
[6] MPEP §2106 II C;
[7] In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006);

Claim Objections

8. As to claim 24, Applicant recites, "...system comprising a license.....relay server includes a second...." Applicant seems to be missing a "**:**" at the following locations, "...system comprising**:** a license.....relay server includes**:** a second...."

Claim Rejections - 35 USC § 101

9. 35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 24-34 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

As to claim 24, 35 USC §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). The Applicant claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC §101. The claims begin by discussing a **system**, but subsequently the claims then deal with the specifics of a **method** (e.g. the steps to perform) executed by the processing means (see rejection of claims under 35 USC §112, 2nd paragraph, for specific details regarding this issue).[9]

Claims 25-28 are also rejected for being dependent upon rejected claim 24. The appropriate correction is required.

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[8] MPEP §2106 II C;
[9] Ex parte Lyell (17 USPQ2d 1548); "A claim of this type is precluded by the express language of 35 USC §101 which is drafted so as to set forth the statutory classes of invention in the alternative only...."

Claims 29, 32 and 34 are also rejected for containing similar language or like deficiencies as to claim 24. The appropriate correction is required.

Claims 30-31 and 33 are also rejected for being dependent upon rejected claims 29 and 32. The appropriate correction is required.

As to claim 24 it is directed to a "unit," a unit is software per se, and according to the MPEP, software, without a computer readable medium storing the software, when executed, causes the computer to perform specific method steps, is non functional descriptive material and is therefore rejected under 35 U.S.C. §101.[10]

Claims 29, 32 and 34 contains similar languages or like deficiencies. The appropriate correction is required.

Claim Rejections - 35 USC § 112, 2nd

11. The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 24-35 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 24, it is considered to be a Hybrid claims since a person of ordinary skill in the art would recognize that the claim encompasses at least two statutory classes of invention. Evidence that Claim 24 recites a system includes: The preamble ("A content distribution system..."), dependent Claim 25, which begins "The content

[10] (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP §2106.01 II).

distribution system...." Evidence to support a construction that the claim is drawn to a method includes "...and send the generated digital signature to the relay server... (Claim 24)" and "...wherein in the case where a frequency band...sends... (Claim 25)." Because of the conflicting evidence, the claim is considered a Hybrid claim and the appropriate correction is required.

Claims 29, 32 and 34 contains similar language and like deficiencies as in claim 24. The appropriate correction is required.

As to claim 24, Applicant recites, "...send the generated digital signature to the relay server, **depending** on a transmission path to the terminal device." However, it is unclear how the term "**depending**" is being used. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The appropriate correction is required.

As to claims 29, 32 and 34 they also rejected as they contain similar language or like deficiencies as in claim 24. The appropriate correction is required.

Claim 24 recites the limitation "the modification" in claim 1. There is insufficient antecedent basis for this limitation in the claim. As to claim 1, Applicant recites a "... judge presence or absence of **the modification** of the first license...." Claim 1 describes a "modification detection unit," but it never describes an actual modification occurring. The appropriate correction is required.

As to claim 25, Applicant recites, "...path is narrower than a **predetermined** frequency....slower than a **predetermined** communication speed...." However, it

appears that Applicant's Specification is silent on how "predetermination" is made or determined. Applicant's Specification cites:

> Also, in the content distribution system, in the case where a frequency band of the transmission path is narrower than a predetermined frequency band or a communication speed of the transmission path is slower than a predetermined communication speed, the modification detection information generation unit may send the modification detection information to the relay server and instructs the relay server to generate the second license.

Applicant's Specification seems to be silent on how this "predetermination" is accomplished. It is not sufficient to cite, within Applicant's claim limitations, the language of "predetermined" if there is no disclosure how this predetermination is accomplished. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The appropriate correction is required.

Claims 25-28, 30-31 and 33 are also rejected for being dependent upon rejected claims 24, 29 and 32. The appropriate correction is required.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 24, 27-29 and 32-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakahara et al., (US 2003/0048907) ("*Nakahara*") and in view of Takahashi et al., (US 7,139,737) ("*Takahashi*").

As to claim 24:

Nakahara teaches substantially as claimed:

> a specification information receiving unit operable to receive an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format (Abstract, [0002], [0011], [0126], [0139], [0157], Figures 1, 19A-G, 20, 21, 24); and
>
> add, to the generated second license, the format specification information received by the license management server ([0011], [0159], Claims 1, 3, 5, 8, 17);
>
> the terminal device includes (Figures 1, 2, 6, 10):
>
> a format conversion unit operable to obtain the second license from the relay server and convert the format of the second license into the first format, according to the format specification information added to the second license ([0007]-[0008], [0047], [0080], [0126], [0130], Claims 4, 8);
>
> a use unit operable to use the content according to the first license in the case where the judgment unit judges that no modification is made ([0005], [0008], [0072]-[0073], [0085]-[0086]);
>
> a first license generation unit operable to generate, in a first format, a first license for controlling content use in the terminal device ([0007], [0009], [0010]-[0011], Figure 2, 17-18, 20-21);

Also, *Nakahara* does not expressly teach where the terminal device contains a "format conversion unit;" however, *Nakahara* does expressly teach where the "conversion apparatus" is "coupled" via a wired or wireless transmission path to a terminal apparatus. Therefore, a predictable result of *Nakahara* would to incorporate a "format conversion unit" within terminal device because one of ordinary skill in the art

would know that it is more efficient to have a "format conversion unit" built into a terminal device rather than to be coupled wired or wirelessly to them.[11]

Nakahara does not expressly teach:

> a modification detection information generation unit operable to generate a digital signature for detecting a modification of the first license and
>
> send the generated digital signature to the relay server, depending on a transmission path to the terminal device;
>
> a judgment unit operable to judge presence or absence of the modification of the first license whose format is converted by the format conversion unit based on the digital signature;

However, the generation of a digital signature to detect modification in a license is a function of the digital signature. The generation of a digital signature to detect modification in a license is old and well known in the art. Also, the transmission of a "digital signature" between servers and terminal device is old and well known in the art because this allows the "digital signature" to be relocated at different locations, to perform the function of verification, where so desired.

Nakahara does not expressly teach:

> a specification information sending unit operable to send the received format specification information to the relay server, the relay server includes a second license generation unit operable to generate, in a second format, a second license by adding, to the first license, the digital signature for detecting a modification of the first license, the second format being different from the first format;

[11] Id;

However, *Nakahara* does expressly teach:

> Claim 5. The conversion apparatus according to claim 1, wherein the **first and second terminal apparatuses are connected to first and second servers, the first and second servers at least generate the first and second license information and transmit the first and second license information to the first and second terminal apparatuses,** and retain first and second format data representing formats of the first and second license information, **the conversion apparatus further comprises a communication section for communicating with the first and second servers to receive the first and second format data,** and the processing section converts the first license information stored in the working area into the second license information compatible with the second terminal apparatus in accordance with the first and second format data received by the communication section.
>
> [0041] FIG. 1 is a block diagram illustrating a conversion apparatus Uc1 according to a first embodiment of the present invention and the peripheral environments thereof. Referring to FIG. 1, **the conversion apparatus Uc1 is coupled to content distribution systems Scd1 and Scd2 via a wired or wireless transmission path N, in a manner capable of data communications. To the content distribution system Scd1, at least one server 21 and at least one terminal apparatus 22 are coupled in a manner capable of data communications via the transmission path N.**

Nakahara teaches the use of "multiple" servers linked together to perform the operation of processing a request to perform a license format conversion. Therefore, a predictable result of *Nakahara* would have been to send format specification information to the relay server because it teaches the use of multiple servers linked together, to perform the operation of license format conversion.[12] Nonetheless, *Takahashi* expressly teaches:

> a license management server ((Col. 6, lines 4-12, 25-67), Figures 1-3);
>
> a relay server ((Col. 6, lines 12-40, 55-65), (Col. 7, lines 10-18), (Col. 13, lines 20-25), Figures 1-2);

[12] Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Nakahara* to include the features of *Takahashi* because these are structural devices commonly used in the transmission of licenses, within a network.

As to claim 27:

Nakahara expressly teaches:

> wherein the license management server includes a first sending unit operable to send the first license to the terminal device (Abstract, [0011], [0094], [0099], Figures 1, 2, 6, 10, 12, 13, 17);
>
> the relay server includes a second sending unit operable to send the second license to the terminal device via the transmission path different from the transmission path in the case of using the license management server (Figure 1); and
>
> the terminal device obtains the second license from the second sending unit ([0011], [0154], [0157], Figure 1, Claims 1, 2, 4).

As to claim 28:

Nakahara expressly teaches:

> further comprising a plurality of servers, one of which is the relay server (Figure 1),
>
> wherein each of the relay servers includes an "n" th license generation unit operable to generate an "n" th ("n" is a natural number that is 2 or greater) license, in an "n" th format, generated by adding, to the first license, the digital signature for detecting the modification of the first license, the "n" th format different from the first format ([0099], [0101], [0166], [0167]) and
>
> the format conversion unit obtains the "n" th license from one of the relay servers and converts the format of the "n" th license into the first format (Figures 1, 17-18, 21, 24)

As to claims 29, 32 and 34:

Nakahara teaches substantially as claimed:

a terminal device (Figures 1, 2, 6., 10);

the terminal device generates the first license by format transformation by obtaining the second license (Abstract, [0011], [0030]-[0031], [0041], [0107], [0108], Figures 17-18, 21, 24);

a first license generation unit operable to generate, in a first format, the first license ([0007], [0009], [0010]-[0011], Figure 2, 17-18, 20-21); and

a specification information receiving unit operable to receive an input of format specification information that is an instruction, to the terminal device, for converting the format of the second license into the first format (Abstract, [0002], [0011], [0126], [0139], [0157], Figures 1, 19A-G, 20, 21, 24);

Nakahara does not expressly teach:

wherein the license management server distributes a first license for controlling content use in a terminal device, the relay server generates, in a second format, a second license by adding, to the first license;

a specification information sending unit operable to send the received format specification information to the relay server;

a server, relay server and terminal device each containing a "conversion unit;"

However, *Nakahara* does expressly teach:

Claim 5. The conversion apparatus according to claim 1, wherein the **first and second terminal apparatuses are connected to first and second servers, the first and second servers at least generate the first and second license information and transmit the first and second license information to the first and second terminal apparatuses,** and retain first and second format data representing formats of the first and second license information, **the conversion apparatus further comprises a communication section for communicating with the first and second servers to receive the first and second format data,** and the processing section converts the first license information stored in the working area into the second license information compatible with the second terminal apparatus in accordance with the first and second format data received by the communication section.

[0041] FIG. 1 is a block diagram illustrating a conversion apparatus Uc1 according to a first embodiment of the present invention and the peripheral environments thereof. Referring to FIG. 1, **the conversion apparatus Uc1 is coupled to content distribution systems Scd1 and Scd2 via a wired or wireless transmission path N, in a manner capable of data communications. To the content distribution system Scd1, at least one server 21 and at least one terminal**

apparatus 22 are coupled in a manner capable of data communications via the transmission path N.

Nakahara does not expressly teach the use of a "Relay Server;" however, it does teach the use of "multiple" servers linked together to perform the operation of processing a request to perform a license format conversion. Therefore, a predictable result of *Nakahara* would have been to send format specification information to the relay server because it teaches the use of multiple servers linked together, to perform the operation of license format conversion.[13]

Also, *Nakahara* does not expressly teach where each server or terminal device contains a "conversion unit;" however, *Nakahara* does expressly teach where the "conversion apparatus" is "coupled" via a wired or wireless transmission path. Therefore, a predictable result of *Nakahara* would to incorporate a "conversion apparatus" within a server or terminal device because one of ordinary skill in the art would know that it is more efficient to have a "conversion unit" built into a server or terminal device rather than to be coupled wired or wirelessly connected.[14]

Nakahara does not expressly teach:

> a digital signature for detecting a modification of the first license, the second format being different from a format used when the first license is generated, and distributes the second license; and

[13] Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007);

[14] Id;

> detects presence or absence of the modification of the generated first license based on the digital signature, and, in the case where no modification is detected, uses the content according to the first license;
>
> a modification detection information generation unit operable to generate the digital signature of the first license, send the generated digital signature to the relay server, depending on a transmission path to the terminal device, and instruct the relay server to generate the second license;

However, the generation of a digital signature to detect modification in a license is a function of the digital signature. The generation of a digital signature to detect modification in a license is old and well known in the art. Also, the transmission of a "digital signature" between servers and terminal device is old and well known in the art because this allows the "digital signature" to be relocated at different locations, to perform the function of verification, where so desired.

Nakahara does not expressly teach:

> the license management server; and
>
> a relay server;

However, *Takahashi* expressly teaches:

> a license management server ((Col. 6, lines 4-12, 25-67), Figures 1-3); and
>
> a relay server ((Col. 6, lines 12-40, 55-65), (Col. 7, lines 10-18), (Col. 13, lines 20-25), Figures 1-2);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Nakahara* to include the features of *Takahashi* because these are structural devices commonly used in the transmission of licenses in a network.

As to claim 33:

Nakahara expressly teaches:

> wherein the second sending unit sends the second license to the terminal device via a transmission path different from the license management server (Figure 1).

As to claim 35:

Nakahara teaches substantially as claimed:

> generating, in a first format, a first license for controlling content use in the terminal device, the generation being executed by the license management server (Abstract, [0011], [0072]-[0073], [0079]-[0080], Figure 1, 5, 12, 17);
>
> receiving an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format, the receiving being executed by the license management server (Abstract, [0002], [0011], [0126], [0139], [0157], Figures 1, 19A-G, 20, 21, 24);
>
> using the content according to the first license in the case where it is judged that no modification is made, the use being executed by the terminal device ([0005], [0008], [0072]-[0073], [0085]-[0086]);
>
> converting the format of the second license into the first format by obtaining the second license from the relay server, according to the format specification information added to the second license, the conversion being executed by the terminal device ([0007]-[0008], [0047], [0080], [0126], [0130], Claims 4, 8);

Nakahara does not expressly teach:

> a server, relay server and terminal device each containing a "conversion unit;"
>
> sending the received format specification information to the relay server, the sending being executed by the license management server;

However, *Nakahara* does expressly teach where the "conversion apparatus" is "coupled" via a wired or wireless transmission path. Therefore, a predictable result of *Nakahara* would to incorporate a "conversion apparatus" within a server or terminal device because one of ordinary skill in the art would know that it is more efficient to

have a "conversion unit" built into a server or terminal device rather than to be coupled wired or wirelessly to them.[15]

Nakahara does not expressly teach the use of a "Relay Server;" however, it does teach the use of "multiple" servers linked together to perform the operation of processing a request to perform a license format conversion. Therefore, a predictable result of *Nakahara* would have been to send format specification information to the relay server because it teaches the use of multiple servers linked together, to perform the operation of license format conversion.[16]

Nakahara does not expressly teach:

> generating a digital signature for detecting a modification of the first license and sending the generated digital signature to the relay server, depending on a transmission path to the terminal device, the generating and sending being executed by the license management server;
>
> generating a second license in a second format different from the first format by adding, to the first license, a digital signature for detecting a modification of the first license, and adding the format specification information received by the license management server to the generated second license, the generation and adding being executed by the relay server;
>
> judging presence or absence of the modification of the first license whose format is converted into the first format based on the digital signature, the judgment being executed by the terminal device;

[15] Id;
[16] Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007);

However, the generation of a digital signature to detect modification in a license is a function of the digital signature. The generation of a digital signature to detect modification in a license is old and well known in the art. Also, the transmission of a "digital signature" between servers and terminal device is old and well known in the art because this allows the "digital signature" to be relocated at different locations, to perform the function of verification, where so desired.

15. Claims 25-26, 30-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Nakahara* and in view of *Takahashi*" and in further view of Sprigg et al., (US 2003/0051169) ("*Sprigg*").

As to claims 25 and 30:

The combination of *Nakahara/Takahashi* discloses as discussed above; however, the combination of *Nakahara/Takahashi* does not expressly disclose:

> wherein, in the case where a frequency band of the transmission path is narrower than a predetermined frequency band or a communication speed of the transmission path is slower than a predetermined communication speed, the modification detection information generation unit sends the digital signature to the relay server and instructs the relay server to generate the second license.

However, *Sprigg* expressly discloses:

> the modification detection information generation unit sends the digital signature to the relay server and instructs the relay server to generate the second license (Abstract, [0030], [0035], [0040]);

Sprigg does not expressly teach:

> wherein, in the case where a frequency band of the transmission path is narrower than a predetermined frequency band or a communication speed of the transmission path is slower than a predetermined communication speed,

However, *Sprigg* does teach:

> [0025] The present invention associates a permission list with the application. The developer of the application, system administrator, or other authority, such as a carrier or device manufacturer, may create or provide input to creating this permission list for the application when used on the device. **In addition a server may be used to create the permission list based on the input from the authorities, entities or parties involved with executing the application on the device.** When the application and permission list is installed on the device, the application when executed will only be allowed access to the resources granted in the permission list. It will be recognized by those skilled in the art that a device may further limit an applications access to resources outside of the permission list. For example, a user may not have rights to a resource on the device that the application is granted permission. This alternative embodiment of the present invention is that the device may provide an additional limitation and, consequently, refuse access to the resource even if the permission has been granted in the permission list based on other privilege levels associated with the device and/or user.
>
> [0030] A server 100 is one mechanism used by the present invention to transfer the application 105 to the device 115. **A permission list (not shown) may be created by the server 100 and associated with the application 105 for use on the device 115.** For secure transmission of the application, as well as any other data transfer, the server may incorporate a modification detection technique, such as a digital signature well known to those in the art. By using this technique, information, such as an application, can be check by the device to determine if it was modified prior to being received by the device. Furthermore, this checking can also occur before every execution of the application to determine if any modification occurred to the information even after being received by the device.
>
> [0035] The above network may be used to send an application and/or permission list to a computer device, such as the wireless device 230. The application, in one embodiment, has a unique identifier to distinguish it from other applications. **The application and permission list may incorporate a digital signature to detect modifications prior to receipt by the device, prior to executing the application, and prior to granting access to a resource to the application.** This digital signature may be bound to the application and permission list and stored on the wireless device either bound or separate, but still associated with, the application and permission list. The application and permission list are sent to the wireless device from the central server to one of the various servers 206 through the MSC and BTS to the wireless devices 230.

Therefore, a predictable result of *Sprigg*, would have been to determine the limitations of "narrowness of a frequency band" or the "communication speed of a transmission path" as precursor to be satisfied for the issuance of a "digital signature" because *Sprigg* discloses the use of a "permission list" where multiple permissions may be created for use with the same application, are associated with a digital signature to detect modifications. One of ordinary skill in the art would know that they could employ

the use of a "frequency band" or "communication speed" as an element of a "permission list.[17]"

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of *Nakahara/Takahashi* to include the features of *Sprigg* because controlling access to application's only when properly authorized to do so is old and well known in the art.

As to claims 26 and 31:

Nakahara expressly teaches:

> wherein the second license generation unit generates the second license whose data size is smaller than a data size of the first license generated in the first format (Figures 1, 17-18, 20-21)

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

> Lindeman et al., (US 7,370,017); FIG. 2 shows a first example of how a benefit can be bound to content. Package 200 contains both the content 14 and a license 210 to use the content. Exemplary license 210 contains rights 212, which permit a particular entity to use the content in some manner. For example, rights 212 may permit a user 210 to consume the content (e.g., play a video) six times, or for 30 days, or in perpetuity. In this example, the license names the entity 214 to whom the rights apply. In this example, that entity is a person ("Joe"), although it should be understood that content can be licensed to any type of entity (e.g., a group of individuals, a corporation, a department of a larger organization, a particular machine, etc.). **Package 200 also contains a cryptographic signature 216, which allows any alteration to package 200 to be detected.**
>
> In the example of FIG. 2, the entity 214 to whom license 210 applies may, for example, be user 2 of FIG. 1. That is, user 2 ("Joe", in this example) may have obtained a license for himself to use the content. When

[17] Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement. KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007);

user 2 redistributes the content in the hope of making a profit from the redistribution, he transmits to a downstream user (e.g., user 1 of FIG. 1) the entire package 200 containing both his own license and the content. User 1 is not able to use the content based on the license that has been issued to user 2 (other than, perhaps, on a trial basis, such as a single play or a 30-second preview). However, licensor 18 (shown in FIG. 1) can be configured to require that user 1 upload the rights portion of package 200 (including the benefit specification) as a condition for issuing a license for user 1 to consume content 14. (Licensor 18 could also be configured to require that user 1 upload the entire package 200; however, this may be inefficient since it requires a large amount of data to be transferred to the licensee that is not technically necessary in order for the licensing transaction to take place.) **Licensor 18 can determine whether any portion of the package has been altered or removed by verifying signature 216. Thus, when user 1 purchases a license for the content, licensor will know that a benefit should be paid to "Joe," since Joe's name appears in license 210 that is transmitted as part of the license request. If Joe's name had somehow been removed from package 200, licensor 18 would be able to detect this removal through verification of signature 216.** (Joe may not actually get paid at the time of the licensing transaction; rather, the licensor may log what licensing transactions have taken place and who should be paid, and thus may be able to make these payments intermittently based on the logs.

Mathur et al., (US 6,839,677); Claim 2. The method of claim 1, wherein the method comprises the steps of: sending, with the first data, by the first server to the client browser, a first digital signature for the first server, wherein the transferring of the first digital signature enables the client browser to transfer the first digital signature to the second server and the second server to verify the first digital signature for the first server.

Matsuyama et al., (US 2002/0026581); [0033] Each of the service provider and user devices performing content transaction may have an encryption processing unit. User devices authenticate one another when data are transmitted there between. Subsequently, a data-transmitting user device generates a digital signature to data to be transmitted, and a data-receiving user device verifies the digital signature.

[0045] Each of the service provider and user devices performing content transaction may have an encryption processing unit. Then, the method may further comprise the step in which user devices authenticate one another when data are transmitted there between. Subsequently the step in which s data-transmitting user device generates a digital signature to data to be transmitted and a step in which a data-receiving user device verifies the digital signature.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

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Thursday, August 06, 2009

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